

Serial No. 10/574,223
Reply to Office Action dated January 24, 2011

Docket No. 1006/0159PUS1

REMARKS/ARGUMENTS

Favorable reconsideration and allowance of the present application is respectfully requested. Claims 1-21 are pending in the above application, of which claims 1, 9, 11 and 20 are independent.

The Office Action dated January 24, 2011, has been received and carefully reviewed. In that Office Action, claims 1-21 were rejected under 35 U.S.C. 102(b) as being anticipated by DE 102 03 003 A1. Objections to the specification and drawings were also raised. It is believed that all claims are allowable over the art of record, and reconsideration and allowance of claims 1-21 is respectfully requested in view of the above amendments and following remarks.

DRAWINGS

The present application is a national stage entry of an international PCT application. As provided by MPEP 1893.03(f): "The drawings for the national stage application must comply with PCT Rule 11. The USPTO may not impose requirements beyond those imposed by the Patent Cooperation Treaty (e.g., PCT Rule 11). However, the examiner does have the authority to require new drawings if the drawings were published without meeting all requirements under the PCT for drawings." The drawings in the PCT application were found to comply with PCT Rule 11, and there is no basis in the record for requiring further changes to the drawings at this time. The requirement for new drawings is therefore respectfully traversed.

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SPECIFICATION

The abstract of the disclosure is objected to. It is respectfully submitted that this objection refers to the abstract filed with the original application and not to the amended abstract as amended on August 2, 2010. It is respectfully submitted that the present abstract satisfies the requirements of MPEP 608.01(b), and the objection to the specification is respectfully traversed.

THE OFFICE ACTION FAILS TO MAKE A PRIMA FACIE CASE OF ANTICIPATION

Claims 1-21 are rejected under 35 U.S.C. 102(b) as being anticipated by DE 10203003. The basis for the rejection is that DE 10203003 "discloses a charge air cooler essentially as claimed." It is respectfully submitted that, on its face, this statement does not constitute a prima facie anticipation rejection under 35 U.S.C. 102(b). There is no basis in U.S. patent law for finding claims to be anticipated on the ground that a reference shows "essentially" what is claimed. If the reference shows exactly what is claimed, a rejection under Section 102 would be proper; if it would be obvious to modify a reference to produce a claimed invention, a rejection under Section 103 would be proper. The Office Action does not satisfy the requirements for a rejection under either 35 U.S.C. 102 or 35 U.S.C. 103, and the rejection is respectfully traversed for this reason.

If the rejection is maintained, it is respectfully requested that the examiner identify the legal authority for rejecting a claim because the claimed subject matter is "disclosed essentially as claimed."

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**THE NEWLY APPLIED REFERENCE IS MERELY A FOREIGN EQUIVALENT OF
THE PREVIOUSLY APPLIED REFERENCE**

Some claims were previously rejected under 35 U.S.C. 103(a) using U.S. Patent No. 7,032,577 to Rosin. The Rosin patent was initially published as U.S. Patent Publication No. 2005/0039729 A1. The Rosin patent claimed priority from DE 10203003. DE 10203003 and U.S. 2005/0039729 were submitted in an IDS with the original application and have been considered according to the initialed form SB/08 in the IFW.

The new examiner has withdrawn an obviousness rejection based on the Rosin patent (in English) and replaced it with an anticipation rejection based on four figures of the German equivalent of Rosin, which figures are identical to the Figures of previously applied 7,032,577. It is respectfully requested that the examiner explain, as required by MPEP 707.07(f), why the rejection based on U.S. 7,032,577 was withdrawn and then explain, in view of the reasons for withdrawing the rejections, why a rejection based on the foreign equivalent of the same document was deemed proper.

The previous examiner acknowledged that Rosin didn't anticipate at least some of the claims; therefore, it is not clear how the new examiner can assert that the German equivalent of Rosin anticipates all claims. At the very least, Applicant's arguments distinguishing the claims over the English version of Rosin should be addressed as required by MPEP 707.07(f) since they remain relevant to the new rejections based on the German version of Rosin.

Specific differences between the claimed invention and DE 10203003 are discussed below. However, the examiner should have responded to Applicant's traversal of the previous rejections in this final Office Action because arguments

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distinguishing the English version of Rosin remain relevant to rejections based on the German version of Rosin. It is therefore respectfully requested that the examiner issue a new final Office Action (if these rejections are maintained) to address Applicant's arguments or issue a new non-final rejection if new references are applied. Otherwise, Applicant will be forced to file a Notice of Appeal merely to obtain a response to previously submitted arguments.

REJECTIONS UNDER 35 U.S.C. 102(b)

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by DE 10203003. Claim 1 recites a charge intercooler for a motor vehicle that comprises a heat exchanger unit with tubes through which charge air can flow and air boxes which are connected to the tubes. The air boxes have a charge air inlet and a charge air outlet, and one of the air boxes includes a partition wall dividing it into first and second portions. The air box also includes a rotary valve rotatable from a first position blocking airflow through the first portion to a second position and allowing air flow through the first portion and the second portion. The drawings in DE 10203003 do not show a rotary valve. Claim 1 is submitted to be allowable over DE 10203003 for at least this reason.

The examiner may be interpreting the pivoting flap 27 in DE 10203003 as a rotary valve on the basis that a pivoting flap is a rotary valve under the broadest reasonable interpretation of "rotary valve." It is respectfully submitted that MPEP 2111, which describes the broadest reasonable interpretation standard, requires that such interpretation be consistent with one that would be used by a person of ordinary skill in

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the art. It is respectfully submitted that "rotary valve" has a recognized meaning in the art and that a person of ordinary skill in the relevant art would not refer to flap 27 of DE 10203003 as a rotary valve. If the rejection of claim 1 is maintained, it is respectfully requested that the examiner provide evidence to show that persons of ordinary skill in this field would call flap 27 a rotary valve or otherwise explain where a rotary valve is disclosed in DE 10203003.

Claims 2-8, 10 and 12-19 depend from claim 1 and are submitted to be allowable for at least the same reasons as claim 1.

Claim 9 was formerly dependent upon claim 1 but was rewritten in independent form in response to the previous Office Action. In addition to some of the claim 1 limitations, claim 9 recites a flap having at least one cutout. No such cutout is shown in flap 27 of DE 10203003. The previous examiner acknowledged that such a cutout was not shown in Rosin and used a secondary reference to try to satisfy this limitation, and it is not clear how the present examiner is interpreting these same drawing figures to show a cutout. It is respectfully requested that the examiner explain for the record the element of DE 10203003 that is being interpreted to satisfy this "cutout" limitation. DE 10203003 does not satisfy at least this limitation of claim 9, and claim 9 is submitted to be allowable for at least this reason.

Claim 11 was formerly dependent upon claim 1 but was rewritten in independent form in response to the last Office Action. In addition to some limitations of claim 1, claim 11 recites a shut-off member designed as a rotary slide. The previous examiner acknowledged that a rotary slide was not shown in Rosin and used a secondary reference to try to satisfy this limitation. DE 10203003 does not include any element

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that could be reasonably interpreted as a rotary slide, and claim 11 is submitted to be allowable over DE 10203003 for at least this reason.

If the rejection of claim 11 is not withdrawn, it is respectfully requested that the examiner identify the element in DE 10203003 that is being interpreted as a "rotary slide."

The former examiner recognized that the Rosin patent was not relevant to the invention of independent claim 20 and did not apply the Rosin reference against this claim. There are so many differences between the invention of claim 20 and DE 10203003 that it is not clear how DE 10203003 in any manner supports an anticipation rejection of this claim. Claim 20 recites a charge intercooler for a motor vehicle, comprising a heat exchanger unit with tubes through which charge air can flow and comprising air boxes which are connected to the tubes and which have a charge air inlet and a charge air outlet. One charge air box is divided by a transverse partition into an entry chamber and an exit chamber which respectively have the charge air inlet and the charge air outlet. Also, one of the charge air boxes is designed as a deflecting box, and a shut-off member is arranged in the transverse partition. DE 10203003 does not show two air boxes and cannot anticipate a claim that requires specific structures for two air boxes. DE 10203003 does not show even one charge air box divided into an entry chamber having a charge air inlet and an exit chamber having a charge air outlet or a transverse portion dividing the air box into the entry and exit chambers or a shut-off member arranged in a transverse portion. DE 10203003 does not show each of these limitations, and for each of these reasons, claim 20 is submitted to be allowable over DE 10203003.

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Claim 21 depends from claim 20 and is submitted to be allowable for at least the same reasons as claim 20.

CONCLUSION

Each issue raised in the Office Action dated January 24, 2011, has been addressed, and it is believed that claims 1-21 are in condition for allowance. Wherefore, reconsideration and allowance of these claims is earnestly solicited. If the examiner believes that any additional changes would place the application in better condition for allowance, the examiner is invited to contact the undersigned attorney at the telephone number listed below.

Deposit Account Authorization

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this, concurrent and future replies, including extension of time fees, to Deposit Account 50-3828 and please credit any excess fees to such deposit account.

Respectfully submitted,



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Date: March 23, 2011